REMARKS

In the Office Action, the Examiner indicated that claims 1 through 39 are pending in the application and the Examiner rejected all claims.

<u>Claim Rejections</u>

In item 2 on page 1 of the Office Action, the Examiner rejected claims 13, 34 and 39 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,216,122 to Elson ("Elson").

At item 4 on page 2 of the Office Action, the Examiner rejected claims 1-4, 6-12, 14-16, 22-24, and 35-38 under 35 U.S.C. §103(a) as being unpatentable over Elson.

At item 5 on page 6 of the Office Action, the Examiner rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Elson and further in view of U.S. Patent No. 5,978,566 to Plank et al.

At item 6 on page 6 of the Office Action, the Examiner rejected claims 12, 17-21, 25, and 27-33 under 35 U.S.C. §103(a) as being unpatentable over Elson and further in view of U.S. Patent No. 5,899,995 to Millier et al.

At item 7 on page 10 of the Office Action, the Examiner rejected claim 26 under 35 U.S.C. §103(a) as being unpatentable over Elson and further in view of Millier et al. and Plank et al.

Applicant provided detailed traversals of these rejections in the Office Action filed on July 9, 2003. Applicant reiterates these arguments herein and will rely upon same in any appeal hereof. Most significantly on point, the present claimed invention is directed a method and system for **creating** rules to process **electronic messages (email)**. Rather than relying

upon user input to decide what rule should be applied, the present invention parses the email message and identifies commonality between the email messages. Rules are then <u>generated</u> based on the comparison. Having the system generate the rules frees the user from having to go through the trouble of identifying which rules to apply and how to have them applied.

None of the references cited by the Examiner, either in the 102 or 103 rejections, teach or suggest these features. Each of them rely upon creation of rules <u>by the user</u> and then application of these rules to existing emails, or, in the case of Millier, files. For these reasons, as well as the reasons set forth in the Response to the Office Action filed on July 9, 2003, the present invention patentably defines over, and is not obvious in view of, the prior art.

Claim Amendments

As the Examiner pointed out in the July 25, 2003 Office Action, the claims prior to the amendments contained herein, did not contain mention of the phrase "automatic" generation with respect to the rules. Applicant submits that since none of the references teach the generation of rules in the manner claimed, the present claims do not require the term "automatic" to be included. However, in an attempt to place the claims in allowable condition, applicant has amended the claims to specifically recite the automatic generation of rules. In addition to not teaching or suggesting the generation of rules, none of the prior art cited teaches the <u>automatic</u> generation of rules. Accordingly, applicant submits that the claims are in allowable condition.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees associated with this communication to Deposit Account No. 19-5425.

Respectfully submitted

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Date

Mark D. Simpson, Esquire
Registration No. 32,942

SYNNESTVEDT & LECHNER LLP
2600 ARAMARK Tower
1101 Market Street
Philadelphia, PA 19107

Telephone: (215) 923-4466
Facsimile: (215) 923-2189

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